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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,336	10/10/2000	Tetsuyuki Kaneko	040256/0120	2188

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David A. Blumenthal  
Foley & Lardner  
3000 K Street, N.W., Suite 500  
P. O. Box 25696  
Washington, DC 20007-8696

EXAMINER

CUNEO, KAMAND

ART UNIT	PAPER NUMBER
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2841

DATE MAILED: 01/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/684,336

Applicant(s)

KANEKO ET AL.

Examiner

Art Unit

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Election/Restriction*

1. Applicant's election with traverse of claims 1-6 in paper No. 5 is acknowledged. The traversal is on the ground(s) that there is no burden to the examiner. This is not found persuasive because burden is shown by different classification, and because applicant has not pointed out any errors in the requirement.

The requirement is still deemed proper and is therefore made FINAL. Claims 7-10 will be rejoined and allowed if they include all of the limitations of an allowed claims.

### *Treatment of Claims Based on Prior Art*

2. 35 USC 103(a) states:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Obviousness under 35 USC 103(a) is determined against a background established by the factual inquires set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), which are summarized in items 1-4 below.

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims

under 35 USC 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 USC 103(c) and potential 35 USC 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-6 are rejected under 35 USC 103(a) as being unpatentable over Steyert, Jr. (US 4171464, hereafter Steyert).

Steyert discloses a wire with superconducting filaments (20) and a metallic covering (18) and ceramic (for example alumina) filaments (22) buried in the surface of the metal covering.

Steyert discloses the claimed invention except for the superconductor being of the oxide type (claim 1). Specifically, he does not disclose the superconductor to be of the Bi type (claim 5), and does not disclose that the metal covering is silver (claim 6). Nevertheless, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use oxide type superconductors, in particular Bi based ones, to increase the current capacity and increase the required operating temperature, because use of Bi based oxide superconductors is old. Further, it would have been obvious to one of ordinary skill at the time of the invention to use silver as the metal covering, because silver is the standard covering metal for oxide superconductors due to its inertness and its oxygen permeability. It has also been held that use of known materials based on their suitability for the intended is within the level of ordinary skill. *In re Leshin*, 125 USPQ 416.

*Related Prior Art*

5. The following references are considered pertinent to the present application.

Nabatame et al. (5849670) disclose use of oxide layers in a high temperature superconductor, but do not teach it to be buried in the surface of the metal matrix.

*Closing*

6. Any inquiries related to the examination of this application should be directed to Ex. K.

Cuneo at (703) 308-1233 or her supervisor Ex. J Gaffin at (703) 308-3301. Inquiries of a general nature should be directed to the receptionist of Group 2800 at (703) 308-0956. The fax numbers for Group 2800 are (703) 308-7722 and 7724.



K. Cuneo  
Primary Examiner Group 2841  
December 14, 2001